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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/300,500 09/02/94 BANERJEE

B M25081DUS

EXAMINER

BRIER, J

24M1/0917

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ART UNIT

PAPER NUMBER

DATE MAILED 2615

09/17/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 6/18/96
- ☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-13 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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DETAILED ACTION

Response to Amendment

1. The amendment to the specification, claim 6 and claim 11 has been entered.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The text of the previous rejection is reproduced below.
4. Claims 1-3 and 6-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by McCain et al U.S. Patent No. 5,309,351. This reference with an effective filing date of October 27, 1988 describes a portable touch screen display which uses an infrared link as a connection to a host computer which performs application processing and provides display information to the portable touch screen display via the infrared link. Especially note column 7 lines 30-33 and lines 58-60 and column 9 lines 46-47 and column 10 lines 41-46 which describes a portable unit constructed of a minimum of parts with limited processing capability. Also note In re Graves, 36 USPQ2d 1697, 1701 (CAFC December 4, 1995) which teaches that fundamental technical information known to one of ordinary skill in the art need not be explicitly taught by the reference for the reference to show that the claimed invention is old under 35 U.S.C. § 102.

Re claim 1:

The stylus of this claim is covered by the operator's finger in the McCain system. In McCain any stylus capable of giving an indication of touch to the touch screen may be considered a stylus.

Re claim 3:

Note column 10 line 64 to column 11 line 3.

Claim Rejections - 35 USC § 103

5. Claims 4 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over McCain et al U.S. Patent No. 5,309,351 and More et al U.S. Patent No. 5,194,852. McCain fails to teach recognition of handwriting entered at the portable touch screen display (claims 4 and 12) and especially does not teach performing the hand recognition analysis at the host computer. McCain does teach a graphics capability in the display at column 8 line 67 to column 9 line 24 which suggests that a graphics input would be desirable in addition to the described menu selection column 9 lines 25-27. A graphics display suggests this because it is desirable to have the input

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resolution equal to the output resolution so it will be possible to have the input and output data correspond to the same pixel location. More describes handwriting detection in a portable computer. It would have been obvious to one of ordinary skill in the art to incorporate handwriting recognition into the host computer of McCain so detailed user input may be detected by the system.

6. Claims 5 and 13 are rejected under 35 U.S.C. § 103 as being unpatentable over McCain et al U.S. Patent No. 5,309,351 and in view of Kannan et al U.S. Patent No. 5,423,045. McCain fails to teach power conservation (claims 5 and 13) in the portable touch screen display. Column 8 lines 43-51 describes the power supply used in McCains' portable touch screen display, but, does not describe a power management circuit for suspending operation of the portable touch screen display under certain conditions. This, however, is taught to be old by Kannan et al. as a means to prolong the life of the battery. For this reason it would have been obvious to one of ordinary skill in the art to incorporate into the portable touch screen display of McCain a power management routine for suspending operation of the portable touch screen display under certain conditions to prolong the life of the battery.

Response to Arguments

7. Applicant's arguments filed 6/18/96 have been fully considered but they are not persuasive.

8. The argument concerning claim 1 has been noted. The rejection of this claim is maintained because at column 7 lines 30-33 the portable touch screen display is described as maintaining the menu driven interface when the host computer runs programs too large for the portable touch screen display to handle. In this mode of operation the display provides responses to the user in response to "positional data representative of a current location of the position input device". This is the typical response that a menu based program provides to the user. An example of visual responses to positional device locations is present in windowing programs. Such programs were in existence prior to the time of applicants invention. Responses to

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positional device locations is described in the previously cited Scientific American article. The portable touch screen display would also send the positional data over the wireless link to the host computer to be used by the program running on the host computer. The wireless transmission of the positional data is the type of fundamental technical information that one of ordinary skill in the art the time of applicants invention would know is necessary for the host computer and the portable touch screen display to perform their programed functions. Furthermore one of ordinary skill in the art would know how to accomplish the transmission of the positional data from basic communication technology. A reference to show such a transmission is not necessary and is inherent to the reference itself. The transmission of data necessary to perform programed functions is described in the previously cited Scientific American article. Thus, McCain teaches the framework of applicants invention and the previous knowledge of one of ordinary skill in the art provides the foundation and explains the inherent functions performed by McCain.

9. The argument concerning claim 6 has been noted. The rejection of this claim is maintained because when the portable touch screen display sends the positional data over the wireless link to the host computer to be used by the program running on the host computer, a wireless receiver/transceiver at the host computer would receive the positional data. The wireless reception of the positional data by the host computer is the type of fundamental technical information that one of ordinary skill in the art at the time of applicants invention would know is necessary for the host computer and the portable touch screen display to perform their programed functions. Furthermore one of ordinary skill in the art would know how to accomplish the

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wireless reception of the positional data from basic communication technology. A reference to show such a reception is not necessary and is inherent to the reference itself. The reception of data necessary to perform programed functions is described in the previously cited Scientific American article.

10. The argument concerning claim 11 has been noted. The rejection of this claim is maintained for the reasons given in support of the rejection of claim 6.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on Monday through Friday from 8:15am to 4:45pm eastern time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powel, can be reached on (703) 305-4700. The fax phone number for this Art Unit is (703)-305-3989.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

September 13, 1996


JEFFERY BRIER
PRIMARY EXAMINER
GROUP 2600